

REMARKS

The comments of the applicant below are each preceded by related comments of the examiner (in small, bold type).

This is a decision on the renewed petition under 37 CFR §§ 1.78(a)(3) and 1.78(a)(6), filed December 12,2008, to accept an unintentionally delayed claim under 35 U.S.C. §§ 120 and 119(e) for the benefit of priority to the prior-filed non-provisional and provisional applications set forth in the concurrently filed amendment.

The petition is **DISMISSED**

A petition for acceptance of a claim for late priority under 37 CFR §§ 1.78(a)(3) and 1.78(a)(6) is only applicable to those applications filed on or after November 29,2000 and after the expiration of the period specified in 37 CFR §§ 1.78(a)(2)(ii) and 1.78(a)(5)(ii). In addition, the petition under 37 CFR §§ 1.78(a)(3) and 1.78(a)(6) must be accompanied by:

- (1) the reference required by 35 U.S.C. §§ 120 and 119(e) and 37 CFR §§ 1.78(a)(2)(i) and 1.78(a)(5)(i) of the prior-filed application, unless previously submitted;**
- (2) the surcharge set forth in § 1.17(t); and**
- (3) a statement that the entire delay between the date the claim was due under 37 CFR §§ 1.78(a)(2)(ii) and 1.78(a)(5)(ii) and the date the claim was filed was unintentional. The Director may require additional where there is a question whether the delay was unintentional.**

The petition does not comply with item (1).

The instant petition does not comply with item (1) above in that the amendment filed concurrently with the instant petition is unacceptable and, therefore, is not considered a proper reference under 37 CFR 1.78(a)(2)(i). In this instance, the amendment has been filed after final rejection and is not entered as a matter of right and must be filed in compliance with 37 CFR 1.116. See MPEP § 201.11. The attached Advisory action from the examiner sets forth the reason(s) for denying entry of the amendment. Before the petition can be granted, petitioner must file a request for continued examination (RCE) under 37 CFR 1.114 (see MPEP §706.07(h) for rules governing the RCE practice).

A request for continued examination (RCE) is being filed concurrently with this petition.

This application (09/832,340) is a continuation-in-part of the 09/698,471 application, which was filed October 27, 2000, and the '471 application is a continuation-in-part of the 09/376,837 application, which was filed August 18, 1999. The '837 application was copending

with the 60/096,988, filed on August 18, 1998, and the 60/142,200 application, filed on July 1, 1999.

Further, the amendment to the specification filed concurrently with the instant petition is not acceptable as drafted since it also improperly incorporates by reference the prior-filed application 09/376,837. An incorporation by reference statement added after an application's filing date is not effective because no new matter can be added to an application after its filing date (see 35 U.S.C. § 132(a)). If an incorporation by reference statement is included in an amendment to the specification to add a benefit claim under 35 U.S.C. § 120 after the filing date of the application, the amendment would not be proper. When a benefit claim under 35 U.S.C. § 120 is submitted after the filing of an application, the reference to the prior application cannot include an incorporation by reference statement of the prior application. See *Dart Industries v. Banner*, 636 F.2d 684, 207 USPQ 273 (C.A.D.C. 1980). See MPEP §§ 201.06(c).

A substitute amendment is enclosed in which the applicant has reordered the amendment to the specification as follows:

This application is a continuation-in-part of United States Patent Application 09/698,471, filed October 27, 2000, which claims the benefit of the filing date of United States Provisional Patent Application 60/161,752, filed October 27, 1999, and United States Provisional Patent Application 60/195,491, filed April 10, 2000, and is a continuation-in-part of United States Patent Application 09/376,837, filed August 18, 1999, which claims the benefit of the filing date of United States Provisional Patent Application 60/096,988, filed August 18, 1998, United States Provisional Patent Application 60/142,200, filed July 1, 1999, and United States Provisional Patent Application 60/142,201, filed July 1, 1999. This application claims the benefit of the filing dates of United States Provisional Patent Application 60/195,491, filed April 10, 2000, and United States Provisional Patent Application 60/230,912 filed September 13, 2000., ~~United States Provisional Patent Application 60/142,200, filed July 1, 1999, United States Patent Application 09/376,837, filed August 18, 1999, and United States Patent Application 09/698,471, filed October 27, 2000,~~ Applications 09/698,471, 60/195,491, 60/096,988, 60/142,200 and 60/142,201 are all incorporated here by reference. ~~This application is a continuation in part of United States Patent Application 09/698,471, filed October 27, 2000, which is a continuation in part~~

Applicant : Ilya Schiller et al.
Serial No. : 09/832,340
Filed : April 10, 2001
Page : 4 of 4

Attorney's Docket No.: 19965-0004001

~~of United States Patent Application 09/376,837, filed August 18,
1999.~~

The above amendment does not incorporate by reference the prior filed application
09/376,837.

**Also, 37 CFR §§ 1.78(a)(3) and 1.78(a)(6) require a statement that
the entire delay between the date the claim was due under 37 CFR §§
1.78(a)(2)(ii) and 1.78(a)(5)(ii) and the date the claim was filed was
unintentional. Since the statement appearing in the petition varies from the
required language, the statement is being construed as the statement
required by 37 CFR §§1.78(a)(3) and 1.78(a)(6). If this is not a correct
reading of the statement appearing in the petition, petitioner should
promptly notify the Office.**

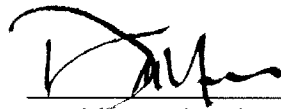
This application is associated with Fish & Richardson P.C.'s customer number 26161.

No fees are believed to be due, as the surcharge under 37 CFR 1.17(t) has been paid
previously. Please apply any other charges or credits to deposit account 06-1050.

Respectfully submitted,

Date: _____

7/21/9



David L. Feigenbaum
Reg. No. 30,378

Fish & Richardson P.C.
Telephone: (617) 542-5070
Facsimile: (877) 769-7945